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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Kevin L. Leffel  
Heidelberg Digital L.L.C.  
2600 Manitou Road  
Rochester, NY 14624

EXAMINER

HENDERSON, MARK T

ART UNIT

PAPER NUMBER

3722

7

DATE MAILED: 03/31/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/994,743

Applicant(s)

WUERSCHUM, HANS-PETER

Examiner

Mark T Henderson

Art Unit

3722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 13, 15 and 17-20 is/are allowed.
- 6) ☒ Claim(s) 1-12, 14 and 16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>5 and 6</u> . | 6) <input type="checkbox"/> Other: ____  |

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## **DETAILED ACTION**

### **Faxing of Responses to Office Actions**

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to Office Actions directly into the Group at (703)872-9306. This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2, 14 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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1. Claim 2 recites the limitation "wire bending element" in 1. There is insufficient antecedent basis for this limitation in the claim.
2. Claim 14 recites the limitation "the free end" in line 2. There is insufficient antecedent basis for this limitation in the claim.
3. Claim 16 recites the limitation "the initial position" in line 2. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 2, 5-8, and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Lemburg (4,281,690).

Lemburg discloses in Fig. 1-19, a process for bending a wire binding element used in binding brochures comprising: bending the wire binding element into a concave shape in segments (Seen Fig. 6-19) at a determined angle Col. 3, lines 29-37); further comprising inserting

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wire binding element into the brochure and closing the binding element (as stated in Col. 6, lines 59-63); starting the bending from an outer periphery (2AA and 2BB, as seen in Fig. 6 and 13).

5. Claim 11 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Jones (4,873,858).

Jones discloses in Fig. 1, 2, 5-7, an apparatus for bending a wire binding element comprising: a base (shown in Fig. 3); a bending unit (30, rotary hammers) to bend the wire element into a concave shape in segments (Col. 2, lines 45-51); and a clamping device (28 and 34) that holds the wire binding element for bending unit (30)

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lemburg.

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Lemburg discloses in Fig. 6-19, a process of bending a wire binding element a plurality of times through deforming tools (37a-44a and 37b-44b as shown in Fig. 6-19).

However, Lemburg does not disclose bending the wire element in the range from 15 to 35 degrees; bending the wire element an angle in the range from 25-35 degrees a plurality of times, and bending wire element 15 degrees a final time.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to bending the wire element at any angle ranges, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233. Applicant has not disclosed the angle range of bending the wire element as critical to his invention and the invention would work equally as well with bending angle range.

***Allowable Subject Matter***

7. Claims 13, 15, and 17-20 are allowed.

8. Claims 14 and 16 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

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9. The following is a statement of reasons for the indication of allowable subject matter: No prior art of record discloses an apparatus for bending a wire binding element used in binding brochures comprising a base; a first bending unit; a second bending unit; wherein each bending unit comprises at least one holding device, one support and a bending bar; and wherein the bending units can be translated individually along a wire loop of the wire binding element; and including all of the other elements of the independent claim.

#### *Prior Art References*

The prior art references listed in the attached PTO-892, but not used in a rejection of the claims, are cited for (their/its) structure. Pigna, Catini, Ishida et al, Adams, Bross, Wahl, Garrity, Jones, Schmid, Jones et al, Pfaffle, Norton, Norton (EP-'243), Jones ('858), Seaborn et al, Bennett, Fabrig, Fabrig ('981), November, Smith, Pigna et al, Trussell, Bagrosky, Jones et al ('538), Adams ('585), Aglaghanian et al, Liouville, Pigna et al ('918), and Adams et al discloses processes for bending wire binding elements.

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**Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)-872-9302. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.



MTH

March 13, 2004



A. L. WELLINGTON  
SUPERVISORY PATENT EXAMINER  
TECHNICAL CENTER 3700